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#23

In re application of Yen Choo et al.
Serial No. : 09/732,348
Filed : December 7, 2000
Attorney Docket No.: 674538-2001

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: DECISION ON PETITION
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This is in response to applicants' petition, filed January 17, 2003 under 37 CFR 1.144, to withdraw the restriction requirement.

BACKGROUND

Review of the file history shows that the application was filed December 7, 2000 under 35 U.S.C. 111(a). The application as filed contained 9 claims. On January 15, 2002 the examiner mailed a restriction requirement dividing the claims into 3 groups. On February 14, 2002 applicants filed a response in which they elected Group III. Applicants then filed an amendment adding claims 10-23 on May 2, 2002. In view of the newly added claims, the examiner mailed a second restriction requirement on July 16, 2002, which divided the claims into 4 groups with linking claims. On August 16, 2002 applicants elected Group III. Applicants traversed the restriction requirement on essentially the same grounds presented in the instant petition. On October 23, 2002 the examiner mailed a first Office action on the merits, in which the restriction requirement was made final.

DISCUSSION

Applicants argue that a restriction requirement can only be made if the inventions are both independent and distinct. Applicants reason that the MPEP is not the law, and the examiner is bound to follow statute, regulation and case law. This line of argument is not persuasive. While applicants are correct in stating that the MPEP is not the law, the MPEP sets forth guidelines for patent examiners to follow in the course of their work. These guidelines are based on the Office's interpretation of statute, regulation and case law. In this instance, the MPEP states:

The law has long been established that dependent inventions (frequently termed related inventions)...may be properly divided if they are, in fact,

"distinct" inventions, even though dependent....The term "distinct" means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). MPEP 802.01.

Applicants argue that Groups I and III, drawn to methods and compositions for activating transcription, are not distinct from Groups II and IV, drawn to methods and compositions for repressing transcription, because all relate to regulation of transcription. This argument is not persuasive. The fact that two or more inventions have something in common does not preclude restriction. For example, acetaminophen and ibuprofen are both organic compounds which can be administered to relieve pain, yet they are patentably distinct. Moreover, applicants are reminded that there are linking claims, and Group IV may yet be examined as stated in the restriction requirement. Applicants' argument that the examiner must provide credible utilities for each of the inventions is not supported by statute, regulation or law, and is not comprehended. Are applicants stating that the claimed invention lacks utility and should be rejected under 35 U.S.C. 101? The utility of the claimed invention is readily apparent.

Applicants argue that the methods of Groups I and II could be used together. This argument is not persuasive, because the methods need not be used together. As stated by the examiner, the two methods utilize different starting materials and produce different effects, and are therefore patentably distinct (i.e. neither would render the other obvious). To return to the example above, acetaminophen and ibuprofen *could* be used together, yet they may also be used separately, and so remain patentably distinct.

Applicants argue that the inventions of Groups I-IV have the same mode of operation. This argument is not persuasive. The Aoyama et al. reference cited by the examiner anticipates the claims of Group III, but not those of Groups I, II and IV. It is clear that, absent an express admission by applicants that the inventions are not patentably distinct, further search and consideration would be required to examine all of the claims.

Applicants argue that all polynucleotides are composed of the same 4 nucleotides and that the polynucleotides of the different groups all encode regulatory proteins. This argument is not persuasive. Applicants need only inspect class 536, subclass 23, to find that many hundreds of polynucleotides, many with similar functions, have been found patentably distinct.

DECISION

Applicants' petition is **DENIED**.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

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